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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,254	11/22/1999	RAY F. BARNARD	EN999116	8410

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EXAMINER

GORT, ELAINE L

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/444,254

Applicant(s)

BARNARD ET AL.

Examiner

Elaine Gort

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. Applicant has indicated that the status of claims 1-23 as "withdrawn" in the amendment filed 5/19/03. This status is incorrect. Claims 4-16 and 23 were canceled in paper number 14 (filed 5/10/02) and claims 1-3 and 17-22 were canceled in paper number 17 (filed 1/2/03).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed program storage device with claimed method steps must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 24-28 are rejected because they lack patentable utility. Claims 1-9 only claim the manipulation of data but perform no concrete, useful or tangible result.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 24-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Lines 51-59 of claim 24 include subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 24-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24-28 are replete with indefiniteness. **Several examples** include:

Claim 24 recites the limitation "said computer" in lines 7, 10, 46, etc... There is insufficient antecedent basis for this limitation in the claim.

It is unclear what is meant and being claimed in regard to "a folders and views section, a task title display and selection area" claimed in lines 49 and 50 of claim 24.

Claim 24 recites the limitation "said summary tasks selection button" in line 51. There is insufficient antecedent basis for this limitation in the claim.

It is unclear what is being claimed as the categories listed in the selection area in lines 54-59 of claim 24. It is further unclear what is meant by the categories listed. For these categories to be given patentable weight a specific definition must be provided.

It is unclear in claim 24 line 56 if the "and" is including all the terms listed after "vendor reporting requirements validation" as categories or if something else is meant.

Claim 25 recites the limitation "said first and second templates" in line 3. There is insufficient antecedent basis for this limitation in the claim.

The above occurrences represent only several examples of existing indefiniteness, therefore, Applicant must review all claims for indefiniteness in response to this rejection.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 24-28, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gundewar et al. (US Patent 6,381,610) in view of Noori.

Gundewar discloses a system and method for coordinating a project capable of maintaining a database of templates with user terminals accessible via a server (column 2, line 66 to column 3, line 8). Gundewar discloses the claimed program storage device but is silent regarding the presence of a tangible program storage device embodying a program of specific instructions to carry out the disclosed method on the system and is silent regarding accounting. It is notoriously old and well known in the art of computerized systems to use computer code instructions to carry out specific procedures automatically. Code instructions are inherent to computer systems. Noorie discloses (see page 378) that it is old and well known in the art of project management to include accounting in project management to ensure the project is carried out within the budget and to know how much the project costs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use computer code instructions and accounting in the system of Gundewar in order to enable the system to automatically carry out the disclosed method and track the cost of a project.

Gundewar discloses a system capable of carrying out the steps of maintaining a database of templates (templates 310 for "major" project tasks and "smaller" project tasks); analyzing and adapting a legacy application (such as development of computer software); coordinating tasks by teams ("some steps and actions...may require intervention by others..." column 7, lines 20+ and "team members" line 38); defining in the assessing phase a solution (see table A, i.e. define and design); initializing and

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modeling a plan in the preparing phase (see table A, i.e. analyze); documenting in the developing phase (see table A, i.e. produce); deploying in the deploying phase (see table A, i.e. produce, optimize, implement and management); providing feedback in the supporting phase (see table A, manage, optimize and implement); and providing user interface templates for designing summary tasks, designing detail tasks and for selecting and creating summary and detailed tasks (project task templates are created and used for designing major and sub tasks).

All other claimed limitations are either disclosed or inherent.

Response to Arguments

11. Applicant's arguments with respect to claims 24-28 have been considered but are moot in view of the new ground(s) of rejection. See details above.

It is unclear from Applicant's arguments which steps are not explicitly recited in Gundewar other than stating that Noorie is used by the Examiner to show that it is obvious to ensure a project is carried out within a budget. Examiner uses Noorie to show that it is obvious in project management to include accounting practices. This was in regard to the method step of accounting claimed in line 30 of claim 24.

Applicant's amendment to the inclusion of "positively recited specific master and subsidiary tasks" are unclear and these these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The claimed steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms


or patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

EG 
May 29, 2003

 5/30/03
ROBERT P. OLSZEWSKI
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